

## REMARKS

Claims 1-23 are pending, claims 1-5 and 21-23 are under consideration. Claims 21-23 have been newly added. No new matter is presented.

Claims 1-5 were rejected under 35 USC 103(a) as being unpatentable over Machida (U.S. Patent No. 5,875,379) in view of Kasuya (U.S. Patent No. 5,571,653). This rejection is respectfully traversed.

Claim 1 recites a toner “containing an organic aromatic solvent and a vinyl monomer in combined concentrations of not more than 500 ppm.” The Examiner admits that Machida does not teach this feature. The Examiner asserts that Kasuya teaches a toner with the claimed properties and asserts that it would have been obvious to use the claimed type of toner in the developing device since such a toner is well known in art for use with a developing device, as disclosed by Kasuya. Applicants respectfully disagree.

When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references. The suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved. When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1355 (Fed. Cir. 1999). Simply because the Kasuya reference may teach the claimed type of toner, there is no suggestion to modify Machida in light of the teachings of Kasuya. Furthermore, the toner disclosed in Kasuya was developed specially for use

with heat as a means to fix the image to the transfer medium (col. 1, lines 13-21). Thus, the toner is developed to withstand this heat so that the toner does not adhere to the heat roll (col. 1, lines 31-38). The problems sought to be solved in Machida are much different. Machida seeks to avoid cracking of the toner when the controlling member is pressed against the surface of the developer carrying member (col. 2, lines 1-12). Therefore, since the problems sought to be solved in Kasuya do not even closely relate to the problems sought to be solved in Machida, there would have been no motivation to use the toner type disclosed in Kasuya in the device of Machida. Therefore, Applicants respectfully request that this rejection be withdrawn and that claims 1-5 be allowed.

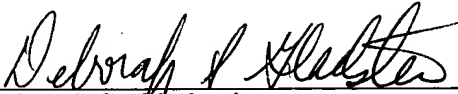
New claims 21-22 are allowable at least due their dependency from claim 1. Claim 23 recites a toner “containing an organic aromatic solvent and a vinyl monomer in combined concentrations of not more than 500 ppm,” as recited in claim 1. Thus, claim 23 is allowable for the same reasons claim 1 is allowable.

In the event that the transmittal is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the

cost of such petitions and/or other fees due in connection with the filing of this document to  
Deposit Account No. 03-1952, referencing 325772026400.

Respectfully submitted,

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